

REMARKS

In summary, claims 1-10 and 15-22 are pending. Claims 1-10 and 15-22 are rejected under 35 U.S.C. § 103. No claims are amended. Reconsideration of the application in view of the following remarks is respectfully requested.

Rejection of Claims 1-10 and 15-22 under 35 U.S.C. § 103(a)

Claims 1-10 and 15-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,069,553, issued to Narayanaswamy *et al.* (hereinafter referred to as “Nara”) in view of U.S. Patent No. 7,181,731, issued to Pace *et al.* Applicants respectfully traverse the rejection because, as previously pointed out, Nara is not prior art.

It is again submitted that Nara is not prior art. The priority date of Nara, which is also Nara’s filing date, is March 3, 2003. In compliance with 37 C.F.R. § 1.131, attached hereto, is an inventor declaration with redacted copies of documents together showing that the claimed invention was conceived prior to March 3, 2003 and that the inventors engaged in reasonable diligence to constructively reduce the invention to practice from prior to March 3, 2003 to the filing date of June 20, 2003, in accordance with 37 CFR 1.131; MPEP 715.07(a) and MPEP 2138.06.

As pointed out in the previous Reply, before March 3, 2003 to June 20, 2003, the inventors collaborated, when necessary, with patent attorneys to prepare the patent application and accompanying documents. While “the actual dates of acts relied on to establish diligence must be provided” per MPEP 715.07 II, diligence in this case “relates to reasonable ‘attorney-diligence’ and ‘engineering-diligence,’ which does not require that ‘an inventor or his attorney ... drop all other work and concentrate on the particular invention involved.’” MPEP 2138.06 (citations omitted). “An applicant may be diligent within the meaning of the patent law when he or she is doing nothing, if his or her lack of activity is excused. Note, however, that the record must set forth an explanation or excuse for the inactivity ...” MPEP 715.07(a). “Diligence must be judged on the

basis of the particular facts in each case.” (MPEP 715.07(a)).

"The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor." MPEP 2138.06. "Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient." MPEP 2138.06 (citation omitted).

Having elected not to disclose specific dates in accordance with MPEP 715.07 II, the inventors state in the declaration that, “we hereby declare that we invented the subject matter of the pending claims prior to March 3, 2003. We further hereby declare that we worked diligently from a date prior to March 3, 2003 to the date of constructive reduction to practice, June 20, 2003, the filing date of the [pending] application, in order to prepare the [pending] application.”

Additional factual evidence showing that work was sustained in a more or less continuous manner is provided in the form of a redacted copy of an invoice (also referred to as an accounting exhibit) showing activity during the time period prior to March 3, 2003 to June 20, 2003. The submitted invoice has been redacted to remove unnecessary business-related information that is not pertinent to the claimed subject matter.

The present Office Action argues that the previous Reply failed to provide a declaration, which accompanies this Reply, and that diligence must be shown from conception to filing of the pending Application (including from the Feb. 4, 2003 Case Administration to the March 7, 2003 review of the invention disclosure), which is not accurate. The declaration and previously submitted exhibits establish the fact that conception occurred prior to March 3, 2003. MPEP 715.07 II “Establishment of Dates” (“if the applicant . . . does not desire to disclose . . . actual dates, [then applicant] may merely allege that [conception] occurred prior to a specified date.”). Also, as previously pointed out, diligence only needs to be shown from just prior to the priority date of Nara

(i.e. just before March 3, 2003) to the filing date of the Application (i.e. June 20, 2003). See 37 CFR 1.131(b); MPEP 715.07(a); MPEP 2138.06 "Critical Period."

"The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses." MPEP 2138.06. Awaiting and supporting the preparation of a patent application is an acceptable excuse following previous conception and preparation of an invention disclosure. In support of this acceptable excuse, an accounting exhibit showing docketing and work on the patent application by a firm/patent attorney was submitted with the previous Reply. The previously submitted accounting exhibit shows affirmative acts in that case administration occurred on Feb. 4, 2003 and, in accordance with the firm's/patent attorney's regular docket of unrelated cases, the invention disclosure was taken up in due course and initially reviewed on March 7, 2003. The accounting exhibit shows work entries on 19 different days from March 2, 2003 to June 20, 2003 when the pending Application was filed. These affirmative acts by the firm/patent attorney inure to the benefit of the inventors.

The accounting exhibit proves the inventors were waiting for and assisting with the drafting of the patent application from Feb. 4, 2003 through June 20, 2003. Having been docketed Feb. 4, 2003, the attorney began studying the disclosure in due course on March 7, 2003, which is only the fourth day after the filing of Nara. The attorney's work, with inventors' support, was directly related to the constructive reduction to practice of the invention, i.e., filing of the Application. It only took 31 days for the firm to receive the case, docket it, assign a patent attorney, and for that patent attorney to begin reviewing the invention disclosure. It took less than 14 weeks to create, review, finalize and file the pending Application.

This is an example of very diligent effort by the firm and patent attorney to prepare and file the pending Application. Clearly, the firm and patent attorney engaged in "reasonable diligence," which is all that is required. They "worked reasonably hard on the application" or, having a "reasonable backlog of unrelated cases [the firm/patent attorney] t[ook] up [the pending Application] in chronological order and carrie[d it] out expeditiously." MPEP 2138.06. Thus, the declaration and supporting exhibits clearly show that Nara is not prior art.

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Accordingly, reconsideration and withdrawal of the rejection of claims 1-10 and 15-22 under 35 U.S.C. § 102(a), based on Nara, is respectfully requested.

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CONCLUSION

Any amendments made during prosecution of the pending application are without abandonment of subject matter. Applicants expressly reserve the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

In view of the foregoing remarks, declaration, and evidence, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested.

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